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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,425	02/18/2004	Patrick A. Lichter	Q33.12-0012	3042
164 7590 08/18/2009 KINNEY & LANGE, P.A. THE KINNEY & LANGE BUILDING 312 SOUTH THIRD STREET MINNEAPOLIS, MN 55415-1002			EXAMINER JIAN, SHIRLEY XUEYING	
			ART UNIT	PAPER NUMBER
			3769	
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			08/18/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/781,425

Applicant(s)

LICHTER ET AL.

Examiner

SHIRLEY JIAN

Art Unit

3769

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 17, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-63 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Restrictions

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-39 and 62-63, drawn to a portable biological data collection system, classified in class 600, subclass 301.
 - II. Claims 40-61, drawn to biological sensor connectors, classified in class 345, subclass 326.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention I discloses a system for collecting portable biological data that does not require the specifics cited in invention II, such as "wherein the sensor-connector end is dimensionally larger than the computer-connector end." The subcombination has separate utility such as modifying non-biological sensors.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or

divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

Election

2. In the event that Invention I is selected, this application contains claims directed to the following patentably distinct species within Invention I:

At present: FIGS. 1-8 and 28-29 are consider generic for all identified species

Species 1: Fig 9- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis ventilator-operation data;

Species 2: Fig.10- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis sleep-related data;

Species 3: Fig.11- schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis ECG data;

Species 5: Fig.12- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis carbon-dioxide detection data;

Species 6: Fig.13- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis hydrogen detection data;

Species 7: Fig.14- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis alcohol detection data;

Species 8: Fig.15- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis sleep-related data including body motion and position and ECG;

Species 9: Fig.16- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis sleep-related data including body motion and position, ECG, EOG and EMG;

Species 10: Fig.17- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis blood pressure related data;

Species 11: Fig.18- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis birth procedure related data;

Species 12: Fig.19- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis blood glucose detection data;

Species 13: Fig.20- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis blood cholesterol detection data;

Species 14: Fig.21- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis blood arterial-blood-gas detection data;

Species 15: Fig.22- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis oxygen detection data;

Species 16: Fig.23- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis body composition data;

Species 17: Fig.24- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis heart beat data;

Species 18: Fig.25- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis ear-drum pressure data;

Species 19: Fig.26- a schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis blood flow related data; and

Species 20: Fig.27- schematic block diagram of a real-time biological data processing PC card for collecting and forwarding on a real-time basis EEG related data.

This application contains claims directed to the following patentably distinct species 1-20. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently claims 1, 25, 31, 62 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an

election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIRLEY JIAN whose telephone number is (571)270-7374. The examiner can normally be reached on M-F 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hank Johnson can be reached on 571-272-4768. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHIRLEY JIAN/
Examiner, Art Unit 3769

/Michael C. Astorino/
Primary Examiner, Art Unit 3769

August 14, 2009